

## **REMARKS**

The Applicant has carefully reviewed the Office Action dated December 13, 2006 and has amended the application to set the claims in condition for allowance. By the virtue of this amendment, claims 1 and 18 are amended. Claim 14 is cancelled. No new matter is added. Support for the amended language is found within the specification and the drawings.

It is not the Applicant's intent to surrender any equivalents because of the amendments or arguments made herein. Reexamination and reconsideration of the application, as amended, are respectfully requested.

### **§112 Rejection:**

The Examiner's rejection under 112 is now moot by the virtue of this amendment reciting a "shaft" as suggested by the Examiner.

### **§102 Rejection:**

Claim 1 is rejected under §102 as anticipated by Ohtsuka (US 5923751).

It is respectfully noted that rejection of claims using a drawing requires that "the picture must show all the claimed structural features and how they are put together" and "[t]he drawings must be evaluated for what they reasonably disclose and suggest to one of ordinary skill in the art." M.P.E.P. §2125.

Further, it is noted that anticipation of claims using a drawing requires that "the picture must show all the claimed structural features and how they are put together" and "[t]he drawings must be evaluated for what they reasonably disclose and suggest to one of ordinary skill in the art." MPEP §2125. Furthermore, anticipation of a claim under 35 U.S.C. §102 (a), (b) and (e) requires that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," that "[t]he identical invention must be shown in as complete detail as is contained in the ... claim" and "[t]he elements must be arranged as required by the claim." M.P.E.P. §2131.

Respectfully, Ohtsuka fails to disclose all the recited elements in the amended claim 1. Particularly, Ohtsuka fails to teach or disclose “a coupling hinge member disposed between the first and second hinge units; a rotation control device for applying pressure to the first hinge member, such that application of pressure to the first hinge member is directly transferred to the coupling hinge member and the second hinge member respectively, to slidably move the first, second and coupling hinge member inside the first and second hinge housings, such that the rotation control device in a first rotation state in cooperation with a biasing force of the spring positions the coupling hinge member inside the first hinge housing, and such that the rotation control device in a second rotation state in cooperation with the biasing force of the spring positions the coupling hinge member inside the second hinge housing; and a shaft disposed in the second hinge housing, wherein the shaft passes through the spring, second hinge member and coupling hinge member, wherein rotation-preventing surfaces are formed on outer circumferential surfaces of each of the first, second and coupling hinge members, such that the rotation-preventing surfaces prevent the first, second and coupling hinge members from rotating inside the first and second hinge housings when said rotation-preventing surfaces engage an inner circumferential surface of said first and second hinge housings, and wherein the rotation-preventing surfaces are formed on the outer circumferential surfaces of each of the first, second and coupling hinge members, such that the first, second and coupling hinge members can slidably move in and out of said first and second hinge housings without any obstruction and subject to the biasing force exerted by the spring and the rotation control device.”

The Examiner is requested to point out portions of Ohtsuka that teach the above-noted elements with specificity or otherwise withdraw the §102 rejection. It is respectfully submitted, therefore, that claim 1 is in condition for allowance. Claims 2-24 are either dependent on claim 1 or substantially incorporate the elements of claim 1 and should be also in condition for allowance.

**Other §102 or §103 Rejections:**

Claims 2-24 are rejected under §102 or §103 as either anticipated or obvious over either Ohtsuka alone or over the combination of Ohtsuka with Wahl (US6101676).

MPEP §2143 provides: “To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.”

Ohtsuka is directed to a hinge mechanism in which multiple hinge components interact to allow a clamshell type mobile phone to be opened with a single touch. The Examiner contends that elements referenced by numerals 19 and 7 in Fig. 2, respectively correspond to the recited first hinge unit and the first coupling hinge unit. The Examiner has failed, however, to point out with specificity which of the multiple components illustrated in Fig. 2 corresponds to the second hinge unit. Without the benefit of the Examiner’s mindset, the Applicants assume that element 13 may correspond to the recited second hinge unit.

As shown and disclosed in Ohtsuka Fig. 2 and column 2 lines 40-60, shaft 8 is inserted into rotor 13 such that flange 8a keeps element 13 in place inside the mounting portion 6. As shown, neither element 13 nor element 19 can rotatably move inside the mounting portions 2 or 6. Further, neither element 13 nor element 19 can slidably move inside the mounting portions 2 and 6 such that element 17 is positioned inside the mounting portion 2 in a first rotation state and inside the mounting portion 6 in a second rotation state, wherein the first and second rotation states correspond to the rotation state of a rotation control device as claimed. As such, Ohtsuka teaches away from claim 1 as amended.

Wahl is directed to an adjustable clutch hinge assembly for a laptop computer and fails to cure the above-noted deficiencies associated with Ohtsuka. The Examiner has also failed to

provide any motivation or reason for combining the two references. Particularly, since Ohtsuka expressly teaches away from the claimed invention, it would be unreasonable to suggest that a person of ordinary skill would be motivated to combine the two references.

While the suggestion to modify or combine references may come from the knowledge and common sense of a person of ordinary skill in the art, the fact that such knowledge may have been within the province of the ordinary artisan does not in and of itself make it so, absent clear and convincing evidence of such knowledge. C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340, 1352, 48 U.S.P.Q.2d 1225, 1232 (Fed. Cir. 1998) (emphasis added).

Here, the modification or combination proposed by the Examiner is not based on any clear and convincing evidence of a reason, suggestion, or motivation in the prior art that would have led one of ordinary skill in the art to combine the references. Rather, the reason, suggestion and motivation for the combination of references proposed by the Examiner simply is impermissible hindsight reconstruction given the benefit of Appellant's disclosure.

The Federal Circuit has consistently held that hindsight reconstruction does not constitute a prima facie case of obviousness under 35 U.S.C. § 103. In re Geiger, 2 USPQ2d 1276 (Fed Cir. 1987). Unfortunately, the Examiner rather than pointing to what the prior art discloses and teaches as to making the suggested modification relies on assumptions and statements without any support in the record. As such, the Examiner's statements regarding obviousness and motivation to modify are but shortcuts to a conclusion of obviousness devoid of the required analytical approach based on what is actually disclosed in the prior art.

Reliance on impermissible hindsight to avoid express limitations in the claims and setting forth unsupported hypothetical teachings to recreate the Applicant's claimed invention cannot establish a prima facie case of obviousness. Since obviousness may not be established by hindsight reconstruction, Applicants invite the Examiner to point out the alleged motivation to

combine with specificity,<sup>1</sup> or alternatively provide a reference or affidavit in support thereof, pursuant to MPEP §2144.03.<sup>2</sup>

Since no reasonable justification is provided in the Office Action as to how such modification or combination is possible and obviousness may not be established based on hindsight and conjecture, it is respectfully requested that the 103 grounds of rejection be withdrawn.

For the above reasons, neither Ohtsuka nor Wahl either alone or in combination teach or suggest the invention as recited in claim 1. Therefore, it is respectfully submitted that claim 1 is in condition for allowance. Claims 2-24 are either dependent on claim 1 or substantially incorporate the elements of claim 1 and should be also in condition for allowance.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicants have expressly argued herein that such amendment was made to distinguish over a particular reference or combination of references.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California, telephone number (213) 623-2221 to discuss the steps necessary for placing the application in condition for allowance.

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<sup>1</sup> *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

<sup>2</sup> "The rationale supporting an obviousness rejection may be based on common knowledge in the art or "well-known" prior art . . . If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position. When a rejection is based on facts within the personal knowledge of the examiner . . . the facts must be supported, when called for by the applicant, by an affidavit from the examiner."

Respectfully submitted,

Lee, Hong, Degerman, Kang & Schmadeka

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Customer No. 035884

By: 

Lew Edward V. Macapagal  
Registration No. 55,416  
Attorney for Applicant